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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,934	11/25/2003	Rita Bitzer	10537/171A	9401
26646	7590	02/10/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	
DATE MAILED: 02/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,934

Applicant(s)

BITZER ET AL

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. The preliminary amendment submitted on 25 November 2003 has been entered. Claims 18-26 have been canceled and currently claims 1-17 are pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

No support can be seen in the specification for the following claim limitations:

In claim 2 the phrase "oxidizable metal combination".

In claims 3 and 13 the phrases "at least mostly elemental aluminum" and "at least mostly elemental aluminum in powder form".

In claim 7 the phrase "normal clear lacquer" and "tinted lacquer".

In claim 8 the phrase "low proportion of an organic solvent".

In claim 9 the phrase "water-based lacquer".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1755

4. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to what is meant by the phrase "configured to react with oxygen". How is the substance configured to react with oxygen? Clarification is requested.

In claim 2 it is unclear as to what is meant by the phrase "oxidizable metal combination".

In claim 3 it is unclear as to what is meant by the phrase "oxidizable iron oxide, FeO". Is applicant trying to say that this is an example of the oxidizable iron oxide or what? Clarification is requested. The phrase "at least mostly elemental aluminum" is not understood.

In claim 7 it is unclear as to what is meant by the phrase "normal clear lacquer". That is what is "normal"? This claim is also confusing as it would appear that a lacquer would either be clear or tinted. Thus it appears that no other kind of lacquer exists, either it is clear or tinted.

In claim 8 the phrase "a low proportion" is vague and indefinite as "low" is a relative term. The specification provides no guidance as to what is considered to be "low".

In claim 10 it is unclear as to what is meant by the phrase "an average score mark size". The phrase "the braking surface" lacks proper antecedent basis.

In claims 11 the term "coating" claimed as such is indefinite and misdescriptive. See *Ex parte Scott* 66 USPQ 371. The claim should recite "coating composition" which will overcome this specific rejection.

In claim 13 it is unclear as to what is meant by the phrase "oxidizable iron oxide, FeO". Is applicant trying to say that this is an example of the oxidizable iron oxide or what? Clarification is requested. The phrase "at least mostly elemental aluminum" is not understood.

In claim 17 it is unclear as to what is meant by the phrase "an average score mark size". The phrase "the braking surface" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 7, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 4314432.

The reference teaches, in the abstract, an anticorrosion lacquer for organic bonded friction linings such brake and clutch linings comprising phenolic resin, inorganic zinc compounds, optionally silic acid and an adhesive. The amount of the zinc compounds is from 20 to 40%.

The instant claims are met by the reference. It is the position of the examiner that the inorganic zinc compound meets applicants protective substance that reacts with oxygen. Note page 2 of the reference, lines 46-47, which recite the types of inorganic zinc compounds utilized. Thus claims 1-3 and 11-13 are taught by the reference. The amount of the zinc compound is from 20-40% which meets instant claims 4 and 14. With respect to claim 7 while the reference does not recite that the lacquer is clear or tinted, it is the position of the examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc compound would tint the lacquer absent evidence showing otherwise. Thus the instant claims are met by the reference.

7. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent Patent Abstract No. 2002-112318 (abstract of RU 2169164) and Derwent Patent Abstract No. 2001-474589 (abstract of RU 2169165).

The references teach, in the abstract, anticorrosion compositions comprising polyurethane lacquer, highly dispersed zinc powder, rheological additive, and organic solvent.

The instant claims are met by the references. While the references do not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that

Art Unit: 1755

the zinc powder meets applicants protective substance that reacts with oxygen, thus claims 1-3 and 11-13 are taught by the reference. The amount of the zinc compound is from 69.8-79.8 in RU 2169164 and 71.1-79.5 in RU 2169165 which meets instant claims 4-6 and 14-16. With respect to claim 7 while the reference does not recite that the lacquer is clear or tinted, it is the position of the examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc powder would tint the lacquer absent evidence showing otherwise. As for claim 8 the amounts of the organic solvents in the reference appear to be in a relatively low proportion as compared to the other components thus claim 8 is met. Thus the instant claims are met by the references.

8. Claims 1-3, 7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 683,213.

The reference teaches in the abstract, a protective lacquer to protect a mirror against corrosion comprising a film former, polyester resin, and zinc dust. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc dust of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. With respect to claim 7 while the reference does not recite that the lacquer is clear or tinted, it is the position of the

Art Unit: 1755

examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc compound would tint the lacquer absent evidence showing otherwise. Thus the instant claims are met by the reference.

9. Claims 1-9 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 4341659.

The reference teaches, in the abstract, a corrosion resistant lacquer containing a binder, solvent, thinner, pigment and various additives. The pigment contains corrosion resistant powdered zinc alloys. The example found in the abstract teaches the amounts of the components.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc alloys of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. As for claims 4-6 and 14-16 the amount of the zinc alloy present in the composition meets these claim limitations. With respect to claim 7 since pigments are added it is believed that the lacquer would be tinted absent evidence to the contrary. As for claim 8 the amount of the solvents in the example appear to be in a relatively low proportion as compared to the other components such

as the zinc alloy and resin. As for claim 9 the composition contains water. Thus the instant claims are met by the reference.

10. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 3018765.

The reference teaches, in the abstract, a corrosion protective powdered lacquer film composition comprising zinc dust and can contain mixtures of thermosetting binders and pigments such as aluminum powder.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the zinc dust of the reference and/or the aluminum powder meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. The amount of the zinc dust is from 60-90% thus meeting claims 4-6 and 14-16. With respect to claim 7 the reference teaches the addition of pigments and accordingly the lacquer would be tinted absent evidence to the contrary. Thus the instant claims are met by the reference.

11. Claims 1-5, 7-8 and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hestermann et al (US Patent No. 4,337,092).

The reference teaches, in the abstract, examples and the claims, a paint or lacquer composition comprising a corrosion inhibiting pigment and other additives such as solvents, binders etc. (see especially the examples).

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the pigments of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. The amount of the pigments is from 10-60 volume% thus meeting claims 4-5 and 14-15. With respect to claim 7 the reference teaches the addition of pigments and accordingly the lacquer would be tinted absent evidence to the contrary. Thus the instant claims are met by the reference.

12. Claims 1-3, 7-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt et al (US Patent No. 4,321,175).

The reference teaches, in the examples, corrosion protective lacquer compositions, comprising titanium dioxide, iron oxide black pigment, mica, calcium carbonate and other components.

The instant claims are met by the reference. While the reference does not teach that the composition is for a braking surface it should be noted that the phrase "for a braking surface" is an intended utility or future use and as such adds little or no

Art Unit: 1755

patentable weight to the claim. Ultimate intended utility does not make a composition patentable. See *In re Pearson*, 181 U.S.P.Q. 641. It is the position of the examiner that the pigments of the reference meets applicants protective substance that reacts with oxygen, thus meeting claims 1-3 and 11-13. As for claim 7 the reference teaches the addition of a pigment and accordingly the lacquer would be tinted absent evidence to the contrary. As for claim 8 the amount of the solvent utilized in the examples appears to be in a relatively low proportion as compared to the other components. With respect to claim 9 the examples teach the addition of water and accordingly the lacquer could be considered to be water based absent evidence to the contrary. Thus the instant claims are met by the reference.

13. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 976,795.

The reference teaches, in abstract, the examples and the claims, an antifriction coating comprising a lubricant, corrosion inhibitor and solvent. The composition may be used to treat brake rotors and drums (abstract).

The instant claims are met by the reference. It is the position of the examiner that the coating of the reference can broadly be considered to be a "lacquer" absent evidence to the contrary as one definition of the term "lacquer" is known in the art to represent "any of various clear or colored synthetic organic coatings that typically dry to form a film by evaporation of the solvent" (a copy of this definition is included with the office action for applicant's convenience). The corrosion inhibitor is selected from

Art Unit: 1755

aluminum particles, zinc particles and a metal phosphate which meets the protective substance of instant claims 1-3 and 11-13. As for the amount of protective substance (instant claims 4-6 and 14-16) the claims recite that the amount ranges from 40 to 65% (with the solvent (i.e. claim 5 of the reference)) or 70-80% after curing (i.e. without the solvent (claim 9 of the reference)). As for claim 7 the examples teach the addition of pigments thus meeting this claim. Thus the instant claims are met by the reference.

Allowable Subject Matter

14. Claims 10 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The reason is that the prior art fails to teach and/or fairly suggest the limitations found in these dependent claims.

Information Disclosure Statement

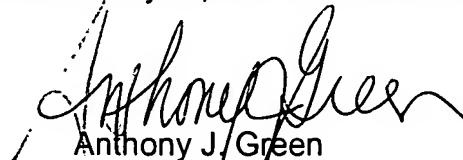
15. The remaining references have been considered however they are not seen to teach and/or fairly suggest the instant invention as they fail to teach the formation of a lacquer composition per se.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
February 04, 2005